

#### **REMARKS**

Claims 1, 23, 28, 31, 32, and 36 have been amended to include the limitation that first and said second catalysts are the same. Support for this amendment can be found, among other places, in Paragraphs [0031], [0032], [0043], [0044], and [0054], and original claims 2, 3, and 5. No new matter has been added through these amendments.

Claims 2 and 3 have been cancelled because of the amendments made to Claim 1.

Claim 29 has been cancelled because of the amendments made to Claim 28.

Claim 69 has been amended to include the transitional phrase "consisting of" instead of "consisting essentially of". No new matter has been added through this amendment.

#### **REJECTIONS UNDER 35 U.S.C 112**

Applicants note with appreciation the Examiner's withdrawal of the rejections under 35 U.S.C 112, first paragraph and second paragraphs.

#### **REJECTION UNDER 35 U.S.C. 103**

The rejection of claims 1-49 and 69 has been maintained under 35 U.S.C. 103(a) as being obvious in light of United States Patent Number 4,228,297, Haeberli et al. ("Haeberli") in view of Grant et al. ("Grant") (Chemical Dictionary, 1990, p.11-12).

#### **EXAMINER'S POSITION**

The Examiner has cited the same reasons outlined in the prior Office Action dated June 1, 2007. Thus, the Examiner takes the position that Haeberli discloses a process for producing hydroxyalkylphenyl derivatives by adding methyl acrylate, in the presence of an alkaline catalyst, to the alkyl substituted phenolic compound, and adding to the resultant reaction mixture a suitable alcohol in the presence of a second catalyst. The Examiner notes that the present invention differs from Haeberli in that the claimed process uses phosphoric acid in the neutralization step instead of acetic acid. Thus, the Examiner has cited Grant to provide support that phosphoric acid can be used as a substitute for acetic acid in the teachings of Haeberli.

In addition, the Examiner has stated that applicant's arguments concerning the use of two different catalysts are without merit. In particular, the Examiner points to col. 9, lines 1-4 of Haeberli for support that the first and second catalysts used in Haeberli can be the same. The Examiner continues that the above-referenced section of Haeberli also provides support that a single catalyst can be used in the Haeberli process.

### APPLICANTS' POSITION

It is applicants' position that one having ordinary skill in the art and knowledge of Haeberli and Grant at the time the invention was made would not have found it obvious to arrive at the presently claimed invention.

Claims 1, 23, 28, 31, 32, and 36 have been amended to include the limitation that first and said second catalysts are the same. While the Examiner contends that Haeberli includes disclosure that the first and second catalysts used therein can be the same, applicants respectfully disagree. It is applicants' position that the first and second catalysts used in Haeberli can be selected from the same class or types of compounds, as evidenced by the disclosure at col. 9, lines 1-4 of Haeberli. However, it is applicants position that the first and second catalysts used in Haeberli must be different, see, for example, Haeberli col. 8, lines 52-58:

After the completion of the reaction, the reaction mass is advantageously cooled to about 60°C to 80°C. Immediately thereafter, a compound of Formulae Ia to IVa is added together with from 0 to 10 mole percent, preferably from 1 to 5 mole percent, of a second alkaline catalyst, different from the first alkaline catalyst (emphasis added), and optionally an inert organic solvent.

Applicants also respectfully point the examiner to the Examples of Haeberli for further support that different catalysts are used as the first and second catalysts of Haeberli.

Applicants also assert that Claims 38 and 69 also differ from Haeberli in that a single catalyst is used in these claims, which is not taught by Haeberli. While the Examiner contends that Haeberli contains adequate disclosure that the same catalyst can be used as the first and second catalysts in Haeberli, applicants respectfully disagree for the reasons noted above. Thus, it is applicants' position that since Haeberli requires the use of two separate catalysts, which are different from each other, Haeberli does not disclose the use of a single catalyst as described in Claims 38 and 69.

Further, claim 69 utilizes the transitional phrase "consisting of", and applicants submit that the addition of ethyl alcohol as taught in Haeberli, see col. 10, lines 50-51, is outside of the scope of the invention embodied in claim 69.

The examiner is requested to reconsider and withdraw these rejections.

Based on the preceding arguments and amendments, the Examiner is requested to reconsider and withdraw all rejections and pass this application to allowance. The Examiner

is encouraged to contact applicants' attorney should the Examiner wish to discuss this application further.

Respectfully submitted:

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